

## REMARKS

Applicants have carefully considered the Office Action dated January 27 2009. Claims 1-4 and 6-17 are pending in this application, and each of those claims stands rejected in the Office Action dated January 27, 2009. Applicants respectfully request reconsideration of each of the rejected claims in light of the remarks presented below.

### Rejections under 35 U.S.C. § 102(e)

Claims 1-4 and 6-9 now stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,010,525 issued to Bonutti et al. On pages 2-3 of the January 27, 2009 Office Action, the rejection asserts

Bonutti et al disclose, at least in figures 26-28 and col. 26, line 63 to col. 28, line 24; a device including **a first anchor (540)** having a locking mechanism (542) configured to grip and hold or lock a suture at any point along the suture; and a cannula (544) including a first lumen (578), **the first anchor being shaped to seat below the first surface of soft tissue (54)** or is capable of seating below the first surface of a meniscus, whereby proper seating of the device closes a defect without interfering with joint articulation.

(emphasis added). Applicants respectfully traverse this rejection. Rather than teaching that the suture retainer 540 is “shaped to seat below the first surface of the soft tissue” as recited in claims 1 and 6, Bonutti in fact teaches just the opposite: “[t]he bottom side surface 564 of the base portion 542 [of suture retainer 540 is] pressed against an upper side surface 98 of the body tissue 54.” *See* Bonutti, at col. 28, lines 21-23. As such, Bonutti cannot anticipate claims 1 and 6 or dependent claims 3, 4, and 7-9 under Section 102.

MPEP § 2131 sets forth the standard for anticipation under 35 U.S.C. § 102. Quoting *Verdegaal Bros. v. Union Oil Co. of California*, that section states that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (internal quotations omitted)). More recently, the Federal Circuit stated that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed

and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net Money!N v. Verisign*, 545 F.3d 1359, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008). In this case, Bonutti does not teach or suggest a “first anchor being shaped to seat below the first surface of the soft tissue” and therefore cannot anticipate claims 1-4 and 6-9 under Section 102.

Indeed, to find that Bonutti anticipates claims 1-4 and 6-9, the rejection had to completely ignore Bonutti’s disclosure. Bonutti clearly teaches a structure designed engage with the largest possible *upper surface* area of the body tissue 54. Such a structure is the very antithesis of an anchor “shaped to seat *below* the first surface of the soft tissue.” As Bonutti explains at col. 1, lines 24-29, it is “desirable to be certain that the suture applies a desired amount of force to the body tissue when the suture is secured. *The overall force transmitting capability of the suture should be maximized without concentrating the force at a small area on the body tissue.*” (emphasis added). To accomplish that objective, Bonutti discloses suture retainer 540, which has a “bottom side surface 564” that is “pressed against an upper side surface 98 of the body tissue 54 in the manner illustrated in FIG. 26.” Bonutti, at col. 28, lines 21-23. Bonutti then describes that “[t]he flat circular bottom side surface 564 of the flange 548 transmits force from the suture 52 to a relatively large area on the surface 98 of the body tissue 54.” *Id.* at col. 28, lines 24-27. In other words, the suture retainer 540, the very embodiment relied on by the rejection, far from “being shaped to seat *below* the first surface of the soft tissue,” is designed specifically to seat not just on top of the surface of the soft tissue but *on largest possible area on top of the surface of the soft tissue* so as to maximize the overall force transmitting capability of the suture.

The rejection is simply mistaken as to the nature and purpose of the suture retainer 540 of Bonutti. Bonutti does not disclose a “first anchor being shaped to seat below the first surface of the soft tissue;” as such, Bonutti does not disclose each and every element of claims 1-4 and 6-9. For that reason, Applicants submit that Bonutti cannot anticipate claims 1-4 and 6-9 under Section 102 and ask the Examiner to withdraw the Section 102 rejection of those claims.

#### **Rejection under 35 U.S.C. § 103(a)**

Claims 10-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonutti in view of U.S. Patent No. 5,391,173 issued to Wilk. On page 4 of the January 27, 2009 Office Action, the rejection asserts

Bonutti et al. disclose the invention substantially as claimed. . . . However, Bonutti et al. do not disclose that the first anchor has a frustoconical end shaped to bury into and seat below the first surface of the soft tissue. Wilk teaches, at least in figures 1, 2C, and 2D and in col. 3, line 66 to col. 4, lines 39-50; a suture anchor (8) including an external frustoconical shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Wilk, to modify the first anchor of Bonutti et al. so that it has a frustoconical shape or end-shape. *Such a shape would provide a tapering surface for engagement of the anchor with a tool or by hand and allow sliding or pushing of the anchor along a suture and towards (or into) soft tissue.*

(emphasis added). Applicants respectfully traverse this rejection for reasons similar to those set forth above in regard to the rejection of claims 1-4 and 6-9 under Section 102. Namely, Bonutti teaches away from any shape that minimizes or lessens the surface area over which the suture retainer 540 engages with the body tissue. For that reason, a person of ordinary skill in the art would not have found it obvious to modify the suture retainer 540 of Bonutti in the manner proposed by the rejection.

Any rejection under 35 U.S.C. § 103(a) must be supported by an explicit analysis of obviousness. *See KSR Int'l. Co. v. Teleflex, Inc. et al.*, 127 S.Ct. 1727, 1741 (2007). The Board of Patent Appeals and Interferences recently reinforced this point, stating that “obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some ‘apparent reason to combine the known elements in the fashion claimed.’” *Ex parte Whalen*, 89 USPQ2d 1078, 1084 (Bd. Pat. App. & Int. 2008) (quoting KSR, 82 USPQ2d at 1396). The KSR Court emphasized the principle that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR*, 127 S.Ct. at 1740 (citing *U.S. v. Adams*, 383 U.S. 39, 51-52 (1966)). For that reason, the analysis of obviousness must consider the prior art “in its entirety, *i.e., as a whole*, including portions that would lead away from the claimed invention.” *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1550-51 (Fed. Cir. 1983) (emphasis added). In this case, the rejection completely ignores the disclosure set forth in Bonutti and proposes to modify Bonutti in a manner that is directly contrary to what is taught in Bonutti. Applicants submit that any rejection on obviousness grounds that fails to even attempt to address the contrary teachings found in the references themselves cannot be proper.

As discussed above, the suture retainer 540 of Bonutti is designed specifically to seat not just on top of the surface of the soft tissue but *on largest possible area on top of the surface of the soft tissue*. Bonutti stresses the importance of that feature at col. 1, lines 24-29, where it states that it is “desirable to be certain that the suture applies a desired amount of force to the body tissue when the suture is secured. *The overall force transmitting capability of the suture should be maximized without concentrating the force at a small area on the body tissue.*” (emphasis added). Replacing the “*flat circular* bottom side” of suture retainer 540 with a “frustoconical end shaped to bury into and seat below the first surface of the soft tissue” would completely eliminate that feature. Indeed, such a modification would create a device that would more likely *concentrate the force at a small area* rather than spreading the force out over a large surface area of the body tissue. In light of Bonutti’s clear teaching to the contrary, Applicants submit that a person of ordinary skill would not modify the suture retainer 540 in the manner proposed.

The analysis of obviousness “not only permits, but requires, consideration of common knowledge and common sense.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (2006). Here, common sense clearly dictates that a person of ordinary skill would not modify the Bonutti device “to bury into and seat below the first surface of the soft tissue” when Bonutti clearly teaches away from that modification. The rejection makes no attempt to show why a person of ordinary skill would ignore Bonutti’s disclosure and create device that is simply unable to maximize overall force transmitting capability of the suture. In light of Bonutti’s clear teaching, Applicants submit that no one skilled in the art would modify Bonutti in the proposed manner.

The rejection has failed to establish a *prima facie* showing that claims 10-17 are obvious over Bonutti and Wilk. Applicants therefore ask the Examiner to withdraw the Section 103 rejection of those claims.

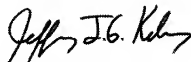
### **Conclusion**

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance. Applicants hereby solicit to action to that end.

Applicants further respectfully ask the Office to consider this paper a Petition for an Extension of Time sufficient to effect a timely response and ask that shortages in other fees be charged or any overpayment in fees be credited to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 26502-73682.

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Shawn D. Bauer", is written over a horizontal line.

Shawn D. Bauer

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